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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/526,777	03/16/2000	Jon K. Curry	1019-P-1	1768
7590		11/01/2007	EXAMINER	
Tod R Nissle Esq		XAVIER, VALENTINA		
Tod R Nissle PC				
P O Box 55630		ART UNIT		
Phoenix, AZ 85078		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/526,777	Applicant(s) CURRY, JON K.	
	Examiner Valentina Xavier	Art Unit 3644	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-15 is/are pending in the application.
- 4a) Of the above claim(s) 14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13 and 15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 13 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koros et al (5593157).

With regard to claim 13, disclosed is an animal toy including an elongate bendable elastically deformable hollow thin-walled non-spherical (a football is read as non-spherical; col. 6, lines 42-49) rubber core (12) sealingly circumscribing and enclosing a selected compressible gaseous volume and including a center, a non-spherical outer surface, a wall one-sixteenth to five-sixteenths of an inch thick (col. 2, lines 30-32) and points on the outer surface at varying distances from the center – it is inherent that a rubber core when bent would be subject to tensile forces while another part of said core is subjected to compressive forces, as is the material property of rubber; a cover (18) affixed to the outer surface of said core, said cover comprising a firm woven cloth heavily napped. Not disclosed is the cloth being shrunk. In the absence of any stated problems solved by or any stated advantage

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obtained by shrinking the cloth as claimed in the instant invention. It would have been obvious to one of ordinary skill in the art at the time the invention was made to shrink the cloth of Koros et al. Further such modification is merely an alternate equivalent affixing means performing the same intended function. Also disclosed is at least one elongate strip (21) of material extending over said outer surface.

With regard to claim 15, disclosed is an animal toy including an elongate bendable elastically deformable hollow thin-walled non-spherical (a football is read as non-spherical; col. 6, lines 42-49) rubber core (12) sealingly circumscribing and enclosing a selected compressible gaseous volume and including a center, a non-spherical outer surface, a wall one-sixteenth to five-sixteenths of an inch thick (col. 2, lines 30-32) and points on the outer surface at varying distances from the center – it is inherent that a rubber core when bent would be subject to tensile forces while another part of said core is subjected to compressive forces, as is the material property of rubber; a cover (18) affixed to the outer surface of said core, said cover comprising a firm woven cloth heavily napped. Not disclosed is the cloth being shrunk. In the absence of any stated problems solved by or any stated advantage obtained by shrinking the cloth as claimed in the instant invention. It would have been obvious to one of ordinary skill in the art at the time the invention was made to shrink the cloth of Koros et al. Further such modification is merely an alternate equivalent affixing means performing the same intended function. The toy is capable of bouncing along a straight line or erratically.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 13 and 15 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 2 of U.S. Patent No. 6415740. Although the conflicting claims are not identical, they are not patentably distinct from each other because coextensive in scope.

Response to Arguments

Applicant's arguments filed 03/18/2005 have been fully considered but they are not persuasive.

In response to applicant's argument that the shrinking of the felt material would produce a surface that is resilient, smooth, less likely to get caught in the teeth of a dog and more difficult for a dog to tear off the toy, the cover taught by the Koros et al reference is functionally equivalent since it is disclosed as being resilient, soft, and seamless (Col. 2; Lines

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21 – 30), which would perform the same intended function as the one provided by shrinking of the felt material.

In response to applicant's argument that a conventional sealed object such as a football is substantially rigid, Examiner respectfully disagrees since the rigidity of the structure of a football is only dependent on the degree to which it is inflated. Furthermore, although a football is not intended for bending, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Valentina Xavier whose telephone number is (571) 272-9853. The examiner can normally be reached on Mon - Fri 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teri Luu can be reached on (571)272-7045. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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